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BY: Christina Halliday

DATE: 5/9/07

Response Under 37 C.F.R. § 1.116  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re:	Patent Application of Christopher I. Halliday	: Group Art Unit: 2155
		:
		:
Appln. No.:	09/922,487	: Examiner: Kevin Bates
		:
Filed:	August 3, 2001	:
		:
For:	Method and Apparatus for Selecting Satellite Audio Radio Channels	:
		:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the final Office Action dated March 31, 2007 (the final Office Action), applicant requests a pre-appeal brief review of the final rejection of independent claims 41, 43, 52, 61, 74, 75 and 76. A Notice of Appeal has been timely filed and no claim amendments are filed herewith.

The independent claims stand finally rejected under 35 U.S.C. § 112 first paragraph, for the inclusion of the word "single" in the claims. The independent claims also stand finally rejected under 35 U.S.C. § 103 as unpatentable over Robbins, U.S. Patent No. 6,317,882, in view of Titlebaum et al., U.S. Patent No. 6,549,774, in further view of Owens et al., U.S. Patent No. 6,067,278. With respect to the § 112 rejection, applicant submits that (1) in the absence of the word "single" in the claims, the claims were already limited to a method and apparatus where the same receiver performs all of the claimed limitations, and (2) the specification supports the claimed limitation at issue and the Office recognizes the support for the limitation in the Office Action itself. With respect to the § 103 rejection, applicant submits that (1) the independent claims, when considered as a whole, recite limitations that are patentably distinct from the art of record, and (2) the Office itself suggested limitations to distinguish the invention over the art and the final Office Action fails to provide any reasoning as to why these same limitations fail to distinguish the claimed invention over the cited art.

**A. The Rejection Under 35 U.S.C. § 112 Is Improper**

In the present case, applicant is currently claiming embodiments of the invention which include one receiver which performs all of the receiver functions recited in the claims. Applicant reserves the right to claim a system of multiple receivers in later filed continuation applications.

By virtue of antecedent basis alone, the limitations relevant to the rejection refer to "the receiver." None of the limitations refer to any other receiver, e.g., none refer to "a second receiver" or "an auxiliary receiver." Clearly, a plain reading of the claims indicates that one receiver performs all receiving functions recited in the claims. Furthermore, and as explained at the bottom of page 12 of the Response to the Office Action, dated January 4, 2007, (the Response) the Office previously acknowledged support for the inclusion of the word "single" on October 30, 2006.

Moreover, on page 2 of the final Office Action, the Office openly accepts the evidence in applicant's own specification that supports the claimed limitation in the first full paragraph of page 6. Specifically, the Office indicates that the cited paragraph supports "at least one satellite radio receiver." Here, applicant has elected to claim one receiver. The now rejected clarifying limitation was merely added in an effort to more distinctly point out that a single receiver is used to perform multiple functions. Accordingly, because the specification fully supports the claimed limitation, applicant respectfully requests withdrawal of the rejection.

**B. The Claim Rejections Under 35 U.S.C. § 103 Are Improper**

In the present case, applicant submits that the Office has failed to correctly determine the scope and content of the prior art and to specify the level of ordinary skill in the art at the time of the invention. In the history of the prosecution of this case, at no time has the Office met its burden under the *Graham* factors, and accordingly, applicant requests withdrawal of the rejection.

Applicant submits that the rejection of the claims under 35 U.S.C. § 103 is also improper at least because (1) the claims are distinguished from the cited art, and (2) the art teaches away from the claimed invention, and the Office has not provided a reasoned basis for rejecting the amended claim limitations.

**1. Even If Combined, the Combination Fails to Arrive at the Claimed Invention**

The Office's conclusion that the claimed invention is a "combination invention," is unsupported by any evidence and is incorrect because it ignores (1) the claims, and (2) the explicit evidence of the cited references showing that even if the references were combined or modified in the manner suggested by the Office, one of skill in the art would still not arrive at the claimed invention. Specifically, the alleged and hypothetical combination leads one of ordinary skill in the art to a main satellite audio radio receiver in combination with one or more auxiliary satellite audio radio receivers, where each auxiliary receiver is in communication with the main receiver via a comparator. This is far different from applicant's claimed invention where a single receiver performs multiple functions.

As explained in section 1A(iii) in the Response on about page 18, this is because, at least, in the cited art (1) the auxiliary receivers scan, (2) there is no teaching that the main receiver scans, and (3) applicant respectfully submits that without auxiliary receivers, no scanning would occur because one or more auxiliary receivers are factually required for scanning data streams.

Moreover, and as explained in the Response at section 1A(ii), Robbins explicitly requires auxiliary receivers to be present. Thus, one of skill in the art, following the ordinary course of innovation would include one or more auxiliary receivers. In the absence of one or more auxiliary receivers, no scanning would occur - thereby rendering Robbins non-functional.

Additionally, because Robbins teaches that only the main receiver permits saving an ID code of a user selection, in the absence of a main receiver, there would be nothing selectively saved in a memory to which to compare the ID codes provided from the scanning auxiliary receiver(s), thereby again rendering Robbins non-functional. See, e.g., *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

At the time of the invention, one of skill in the art had no expectation of success at arriving at the claimed invention and the Office's position with respect to its characterization of the presently claimed invention as a "combination invention" flies in the face of common sense upon a reading of the references. Even if the Office were to take account of the inferences and creative steps that a person of ordinary skill in the art would employ, one of skill in the art would still not arrive at the claimed invention.

## 2. The Claimed Invention Provides Indicia of Unobviousness

The Office's misunderstanding of the presently claimed invention is shown clearly on page 18 of the final Office Action. There the Office indicates "There is no clear teaching in any of those sections of any other part of the specification that supports the idea that the claimed invention teaches any more than a receiver system such as Figure 8(a), element 802."

Applicant respectfully submits the patentable advance in the art does not come from adding components to a system or a teaching directed to "more than" a receiver system such as Figure 8(a), which already includes at least one main receiver and at least one auxiliary receiver as actual physical components of the larger system. Rather, the patentable advance comes from, at least, the elimination of a required *physical* component while simultaneously retaining its function. Under MPEP § 2144.04 (II)(B), the omission of an element and retention of its function is an indicia of unobviousness, *In re Edge*, 359 F.2d 896 (CCPA 1966).

As explained on pages 12 through 16 of the Response, the teachings of Robbins requires at least two distinct receiver components running in parallel in a system - namely a main receiver to selectively store information and one or more auxiliary receivers for scanning data streams. Robbins is deficient in

that Robbins does not teach or suggest that the auxiliary receiver selectively stores ID codes based on a user selection. Nor does Robbins teach or suggest that the main receiver scans.

Contrast Robbins with the presently claimed invention wherein the steps of scanning and selective storing of designations (e.g., ID codes and the like) employ the same receiver, rather than two separate receivers each having different functions.

Accordingly, because the claims recite that the claimed functions are performed using one receiver, and because the claimed invention eliminates the need for the auxiliary receiver of Robbins, the applicant has demonstrated that the claimed invention is unobvious and distinguished over the cited art. The BPAI has spoken at length on this issue and upheld the patentability of claims on this basis, as described in *Ex Parte Kazuo Deguchi* 1998 WL 17489621, and *Ex Parte Frank L. Greenway* 1995 WL 1747142.

Moreover, for at least the reasons described in the Response on pages 16 and 17, Robbins teaches away from the claimed invention. Consistent with the holding in *KSR International Co. v. Teleflex Inc.* 550 U.S. \_\_\_\_ (2007), published on April 30, 2007 (see, e.g. page 22 of the Supreme Court opinion), applicant has provided substantial and un-rebutted evidence that (1) the present invention is non-obvious and (2) Robbins teaches away from the claimed invention.

Lastly, at least paragraphs 18, 70, and 71 and the non-limiting prophetic examples, e.g., paragraph 88 clearly show hardware embodiments that support applicant's position. The entire specification, including the figures, is also replete with description of how the steps are taken, for example, paragraph 29 and non-limiting prophetic Example 3.

3. The Office Does Not Provide a Reasoned Basis for Rejecting the Claims in View of Limitations Suggested by the Office

Applicant submits that the Office itself suggested to applicant the now contested limitations which generally recite that the claimed features occur while audio is being provided to a user. During the interview of October 30, 2006, Examiner Bates and Examiner Najjar indicated that if the claims were amended such that the comparison was run in the background while the methods and apparatus provide audio to the user, the claims would be distinguished over the art. Applicant reconfirmed the Office's position and support for the amendment on December 8, and in the Response, applicant complied with the suggestion of the Office and appropriately amended the claims.

Now, in the final Office Action, the Office does not provide any convincing line of reasoning as to why the limitation discussed during the two telephonic interviews fails to distinguish the invention. More precisely, the Office fails to provide any evidence that shows the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

As shown on page 4 of the final Office Action, first full paragraph, rather than address the limitation "received by the receiver...while the receiver is providing audio to the user," which the Office proposed, the Office ignores the very limitation that was previously discussed during the interviews and instead characterizes the claimed invention as an obvious "combination invention," without providing any reasoning or evidence thereof.

Absent evidentiary support, applicant submits that because each and every limitation is not found in the art, either singly in Robbins or in combination with other references, the Office has failed to establish a *prima facie* case of obviousness.

#### C. Conclusion

Applicant has provided substantial evidence that (1) the claim limitations are supported by the original disclosure and the evidence provided by the Office also supports applicant, (2) even if the references were combined in the manner suggested by the Office, one does not arrive at the claimed invention, (3) the claims themselves provide indicia of unobviousness, and (4) the Office has continued to ignore claim limitations that the Office itself suggested to distinguish the invention, the combination of references fails to arrive at the claimed invention.

Moreover, the Office failed to correctly determine the scope and content of the prior art and also mischaracterized the invention as a "combination invention," and by implication, has failed to correctly determine the differences between the claimed invention and the prior art. The Office provides no evidence supporting its conclusory positions, much less a convincing line of reasoning based on any evidence, much less substantial evidence, showing that the claimed invention is obvious. Additionally, the Office has failed to specify the level of ordinary skill in the art at the time of the invention, much less provide any evidence to support any position with respect to a determination of that level of skill.

In view of the foregoing, applicant respectfully requests the reversal of the rejections of record and allowance of the pending claims.

Respectfully submitted,

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05/09/07

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